



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

JOSEPH R. BYRUM *et al.*

Appl. No.: 09/960,481

Filed: September 24, 2001

For: Nucleic Acid Molecules and Other
Molecules Associated with Plants

Art Unit: 1631

Examiner: BORIN, MICHAEL L.

Atty. Docket: 38-21(15367)C

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Response to Restriction Requirement

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed June 2, 2003, Applicants submit the following
remarks.

Remarks

The application presently contains claims 1-7. In the Office Action mailed June 2, 2003, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: Claim 1, drawn to polynucleotides, classified in class 536, subclass 23.1;

Group II: Claim 2, drawn to a purified polypeptide encoded by a polynucleotide of Group I, classified in class 530, subclass 300; and

Group III: Claims 3-7, drawn to a transformed plant, classified in class 800, subclass 205.

Additionally the Examiner required election of either a single amino acid sequence or a single nucleic acid sequence. Applicants respectfully traverse the restriction requirement, and provisionally elect Group I (claim 1) drawn to SEQ ID NO: 5278 for further prosecution.

Applicants submit that the complete examination of the application would be handled most expeditiously by treating all of the pending claims as a single entity. As Section 803 of the MPEP directs, “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” Applicants respectfully submit that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. Rather, a serious burden would arise if the application were restricted.

Applicants submit that the restriction requirement is inappropriate. For example, Applicants contend that, at least, Group I and Group II should be examined simultaneously because they are related as nucleic acids and the proteins encoded by said nucleic acids. Accordingly, examination of Group I and II together would pose no undue burden to the Examiner. Furthermore, Applicants submit that restriction to a single nucleotide sequence is improper and Applicants believe no serious burden would result by the search and examination of at least ten nucleotide sequences. Applicants disagree that each sequence in the application is necessarily a patentably distinct species, but provisionally elect the species of Group I (nucleic acids represented by SEQ ID NO: 5278) for further prosecution.

Based upon the foregoing, Applicants submit that the restriction requirement is improper and therefore should be withdrawn. To facilitate prosecution, however, Applicants have provisionally elected, with traverse, Group I (claim 1 drawn to SEQ ID NO: 5278).

Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representative at (314) 694-6343.

Respectfully submitted,



DATE: July 30, 2003

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